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**To:** Commissioner of Patents  
Box DAC  
Washington, DC 20231

**From:** Bernard H. Browne, Jr (Inventor).

**Subject:** Renewed Petition under 37 CFR 1.137(a) for Patent Application 09/655792  
Previously Dismissed Under 37 CFR 1.137 (a) or (b) on October 3, 2002

## SUMMARY

This is a request for a renewed petition under 37 CFR §1.137 (a) to revive an unavoidably abandoned patent (application 09/655792). Per the requirements of 37 CFR §1.137 (a), sections in this petition include the following:

- 1) Statement confirming replies to outstanding office actions
- 2) Petition fee set forth in 37 CFR §1.17(1)
- 3) Showing that the entire delay in filing the required reply from the due date for the reply until the filing was unavoidable

As this utility patent application was filed after June 8, 1995, no terminal disclaimer is required.

Previously on August 7, 2002, we petitioned the USPTO to revive our patent under either 37 CFR 1.137 (a) or 37 CFR 1.137 (b). In this renewed petition we provide conclusive evidence that our delay was unavoidable and this petition includes the specific identification of errors made by the USPTO in assessing our timing which was the only issue in our dismissal. The USPTO errors on timing were not emphasized in our previous petition under either 37 CFR §1.137 (a) or 37 CFR §1.137 (b) which is possibly why neither one of our petitions filed on 08/07/02 were accepted. In view of these errors on the part of the USPTO in assessing our timing and the need to file this additional petition, we also request that our \$640.00 fee previously paid per 37 CFR §1.137 (b) be refunded since the whole timing matter seems to be due to errors in assessing our timing on the part of the USPTO.

We trust that our efforts will not have been wasted and our patent will finally be granted. Since this author and publisher has labored long over this patent filing which has significantly delayed the publication of our next book (our 4th), we also intend to use this experience on this patent filing project as a detailed example in our next book which will now be directed solely on how to file patents in today's environment (as long as there are no legal objections from the USPTO).

11/20/2002 AWONDAF1 00000096 09655792  
01 FC:2452 55.00 OP

Adjustment date: 05/09/2003  
02/08/2002 TSTPTE  
01 FC:215

1

Refund Ref:  
05/09/2003

Credit Card Refund Total:  
\$5.00

Acct Exp.: XXXXXXXXX  
01/03/2003

Adjustment date: 05/09/2003  
11/20/2002 AWONDAF1 00000096  
01 FC:2452

Refund Ref:  
05/09/2003 CKHLD

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OFFICE OF PETITIONS

## **1. STATEMENT CONFIRMING REPLIES TO OUTSTANDING OFFICE ACTIONS**

We hereby state that we have responded to all outstanding USPTO actions. Table 1 attached summarizes the dates of all of our replies to USPTO actions as well as the dates properly or improperly acknowledged by the USPTO on our actions. Figures 1 and 2 attached depict all action timing graphically.

Section 3 of this petition will provide details showing that the assumed delays on our part in filing replies were unavoidable and that the USPTO was erroneous in assessing some critical aspects of our timing.

## **2. PETITION FEE SET FORTH IN 37 CFR §1.17(1).**

Attached to this letter is check number 2241 for the amount of \$55.00 to again petition the acceptance of our timing as being unavoidable.

## **3. SHOWING DELAY IN FILING THE REQUIRED REPLY WAS UNAVOIDABLE**

### **3.1 Summary**

This section shows that any implied delays in filing required replies to USPTO action requests were not the case, and therefore the timing situation would most certainly fall under the category of unavoidable per 37 CFR 1.137 (a). We will start in section 3.2 with direct proof of correct timing on our part. Then in section 3.3, we address every statement made in the "Decision Dismissing Petitions" letter mailed October 3, 2002 showing where errors were made by the USPTO in assessing our timing. Proof is furnished showing that the USPTO conclusions on our timing were incorrect which very likely led to the decisions dismissing our October 7, 2002 petitions related to our timing.

### **3.2 Proof That Inventor's Implied Delays to USPTO Action Items Were Unavoidable**

#### **3.2.1 Summary of All Communications With USPTO**

Table 1 attached summarizes all communications between the inventor and the USPTO including correct dates when actions actually occurred and dates erroneously stated by the USPTO on certain critical actions. In addition, Figures 1 and 2 attached graphically depict all actions of the inventor and USPTO on a horizontal time scale. The two items which apparently are disputed as being untimely are items 6 and 9. The inventor claims, however, that the actions pertaining to items 6 and 9 were timely and the proof will be provided.

### 3.2.2. Response to “Final” Office Action (Item 6 - Figure 2) Was Not Late

Contrary to what the USPTO has claimed, the inventor’s response to the “final action” was not late (see item 6 in Table 1 and Figure 2). Our reply to the USPTO “final action” mailed on October 4, 2001 was mailed on December 24, 2001 well within the three months of the mailing date requested. The certified mail receipt shown in Figure 3 proves our mailing date was December 24, 2001 and not January 15, 2002 as claimed by the USPTO. Therefore the statement by the USPTO that our reply to the final action was late was incorrect and Figure 3 is the proof!

There was, it will be noted, a three week and one day mailing delay due to Christmas and New Years holidays, 9/11 and anthrax mail room contaminations which caused the inventor’s “final response” to be received by the USPTO on January 15, 2002. Proof of this is the return mail receipt shown in Figure 4.

The USPTO is therefore incorrect in stating that our “final action” was late by being mailed on January 15, 2002.

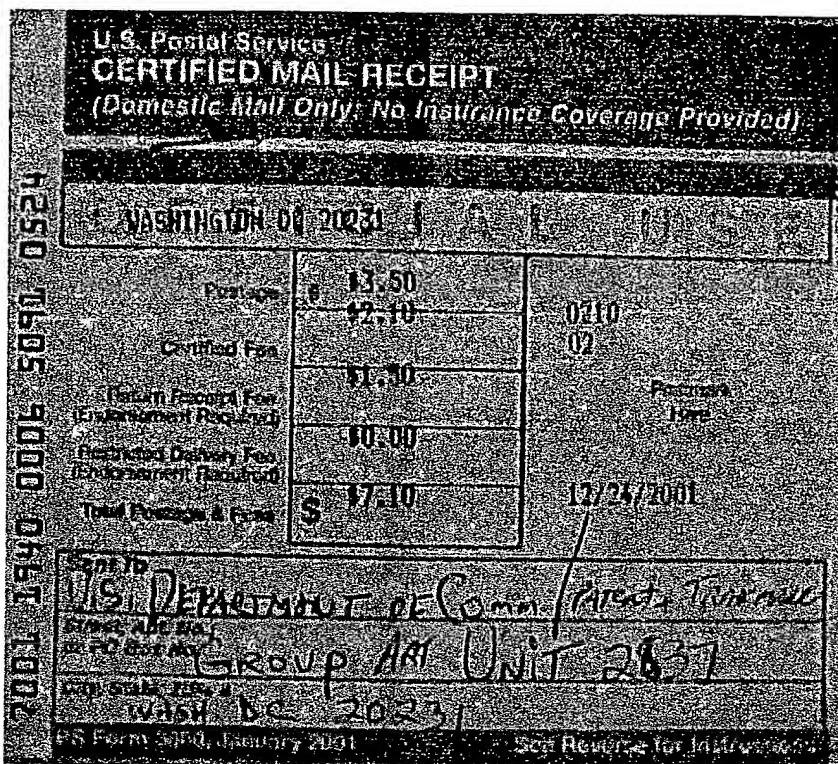


Figure 3 - Certified Mail Receipt Showing Mailing of “Final Action” Eleven Days Early (December 24, 2001).

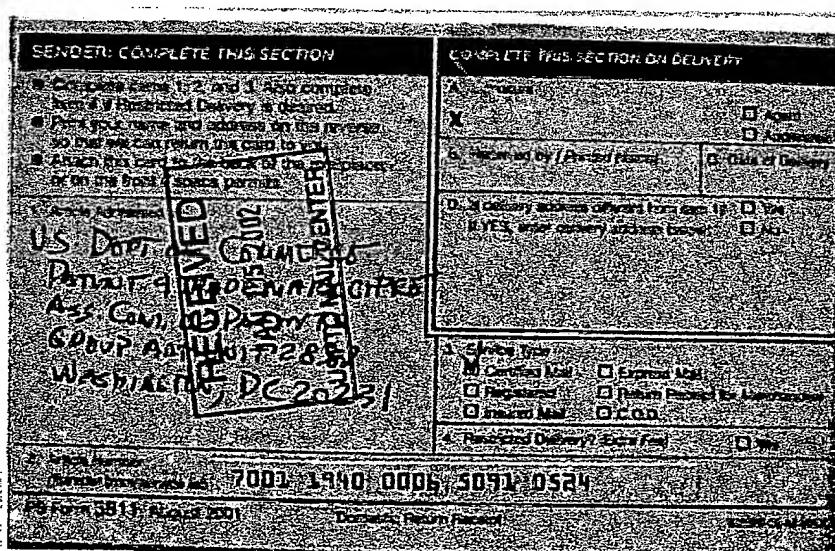


Figure 4 - Certified Mail Return Receipt Showing Extraordinary Mailing Handling Time (22 Days) on Inventor’s “Final Action” Response.

### 3.2.3 Timely Response to Advisory Action (Item 8) Could Only Have Been Met By Turning Back Clocks Several Weeks

The USPTO mailed an advisory action on 2/13/02 (Item 8, Figure 2) which was stated to expire 3 months from the final rejection (Figure 5). It claimed our amended application should comply with rule 37 CFR 1.121. But since the due date of the “final action” material was 01/04/02 that had already past, by any prudent or even the strictest standards, it could only be concluded that this new advisory action set a new action date that was 3 months from its mailing date. Otherwise, we only could have only complied with this advisory action’s request by turning back the clocks!

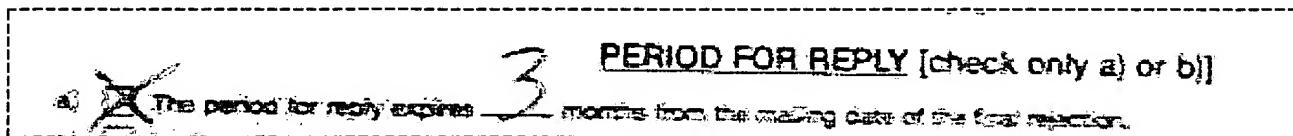


Figure 5 - Timing Requested on Advisory Action Mailed on 2/13/02 (item 8) Over a Month After the Expiration Date of the “Final Action” Item Due Date.

Not being able to turn the clock back, it was only logically assumed that the 3 month response identified meant 3 months from the USPTO mailing date which placed this due date at 5/13/02. This mailing date was met, of course, by our 5/03/02 mailing of 209 pages of material making our amended application is compliance with 37 CFR 1.121.

### 3.2.4 Amended Application Was Filed 5/23/01, Not on 01/15/02

The “final action” item response by the inventor mailed on 12/24/01 (item 6) responded properly to all of the items requested. It provided justification that new material was not added in our amendment filed on 5/23/01, made minor modifications to the wording in a few dependent claims, and provided justification of why our patent was different from the patents of Sitrick, Aoki, etc. This is all that was requested in the USPTO “final action.” mailed on October 4, 2001. There was no request in this “final action” or any request before the final action due date to make our amended application filed on 5/23/01 to comply with 37 CFR 1.121 which is directed at making changes in amended applications clearer.

### 3.2.5 Rule 37 CFR 1.121 Was Not in Effect When Application Was First Filed on 8/31/00

The inventor reviewed the rules that were in effect when he mailed his patent application on August 31, 2000. Being a book author and publisher, however, he resumed his book authoring/publishing business after the patent was filed and was not aware of any new patent rules that came into effect after he filed his application. He, of course, responded in a timely fashion to every action item called for by the USPTO after his initial patent application

filings. Unknown to the inventor were revisions to the patent rules in the Federal Register effective on September 8, 2000 shortly after filing his patent application.

### 3.2.6 Advisory Action Very Untimely and Impossible to Meet Timing

The advisory action mailed by the USPTO on 2/13/02 relating to a request to comply with the new patent rule 37 CFR 1.121 on amended applications was mailed one month and nine days after the due date on our “final action item.” This timing, of course, was impossible to meet unless we were able to turn the clocks back. But more puzzling was why this advisory action relating to the documentation style on amendments wasn’t mailed many months sooner. A very large amendment was filed on 5/23/01 providing the additional patent details (among other things) that was requested in the USPTO communication mailed to the inventor on 01/24/01. The inventor has responded in a timely manner to every request, but he sure wasn’t advised on the rule change relating to amendment documentation style in any timely fashion. In fact, the USPTO advisory action on 37 CFR 1.121 was so late that it could only be met in a timely fashion by turning back the clock!

### 3.2.7 Late Fee Request By USPTO Was in Error and Should Be Refunded

The “late Fee” solicited by phone by the USPTO on 2/08/02 was in error since our response to the “Final Action” was mailed on 12/24/01, not on 01/15/02 as the USPTO claimed in error. Thus, the \$55.00 late fee requested by the USPTO and paid by the inventor on 2/08/02 should therefore be refunded.

## **3.3 Incorrect Statements by USPTO in Oct 3, 2002 “Decision Dismissing Petitions”**

This section points out many errors related to timing stated in the “Decision Dismissing Petitions” letter mailed by the USPTO on 10/03/02. Since the statements in paragraphs in the “Decision Dismissing Petitions” were not numbered, for clarity the inventor has chosen to include copies of every USPTO statement in the “Decision Dismissing Petitions” letter (Figure 2 - item 17) to clarify each of our arguments. These statements are numbered for ease of reference. The errors on the part of the USPTO in the assessing the inventor’s timing no doubt explain why it was believed that we were late on one of our responses without proper cause.

### 3.3.1 Petition Under 37 CFR §1.137(a) Unavoidable OR (b) Unintentional — Not Both

This section relates to the first statement in the USPTO decision letter of October 3, 2002 which we have included in the box to the right.

This is a decision on the petition filed August 12, 2002 to revive the above-identified application under either 37 CFR 1.137(a) or under 37 CFR 1.137(b).

#### **USPTO Decision Statement 1**

In our August 7, 2002 petition, we chose to have the USPTO accept either one of our arguments, whichever one was most appropriate to apply. Thus, it was expected to have one of our checks returned to us. Instead, the USPTO cashed both of our checks for \$55.00 (Unavoidable) and for \$640.00 (Unintentional). We stated we wanted an “OR” situation as mentioned in the boxed decision statement 1 item not and “AND.”

### 3.3.2 There Was Not a Failure to File A Timely Reply to the Final Office Action

Our reply to the decision statement number 2 shown in the box to the right is that this statement is incorrect. The inventor mailed a 24 page response to the

The above-identified application became abandoned for failure to timely file a proper reply to the final Office action mailed October 4, 2001.

#### **USPTO Decision statement 2**

USPTO “final” office action on December 24, 2001. The proof is shown in Figure 3 in the form of a certified mailing receipt proving the mailing date of December 24, 2001. The 24 pages mailed consisted of the material requested by the USPTO on some minor wording changes in our claims and explanations of why our patent was different than material in the patents of Sato, Farrand, Goede, Miyano and Eller. The inventor responded properly and filed this “final” response in a timely fashion.

### 3.3.3 Shortened Statutory Period for Reply Was Met by Inventor

The statutory period for reply of three months was met. Three months from the USPTO’s final office action mailed on October 4, 2001 was January 4, 2002 and our reply to the final office action was mailed on December 24, 2001 (Figure 3).

This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a).

#### **USPTO Decision Statement 3**

### 3.3.4 Amendment Was Not Filed on January 15, 2002

No, as previously proven, our response to the USPTO's "final" action was mailed on December 24, not on January 15, 2002. The applicant did not submit anything on January 15, 2002. Moreover, the inventor submitted a significantly amended application on 5/23/01 in response to the additional detail requested by the examiner in the USPTO's 1/24/01 request. A 30 day extension request and \$55.00 fee was properly paid by the inventor on 4/16/01 which made the amendment timely.

On January 15, 2002 applicant replied with an amendment. However, the amendment was determined by the examiner not to place the application in condition for allowance.

#### **USPTO Decision Statement 4**

### 3.3.5 One Month Extension of Time Not Submitted on January 15, 2002 as Stated

No, this statement is in error. The inventor did not request an extension of time on January 15, 2002 or submit a fee on this date as stated by the USPTO.

It is acknowledged that petitioner submitted the fee for a one-month extension of time on January 15, 2002.

#### **USPTO Decision Statement 5**

What occurred was a person by the name of Trina from the USPTO called the inventor on February 8, 2002 and requested a late fee of \$55.00 without explaining why this fee was requested. Anxious to comply with every USPTO request, the inventor FAXed an American Express account payment authorization of \$55.00 on this very same day the payment was requested. The American Express statement proving that date is shown below.

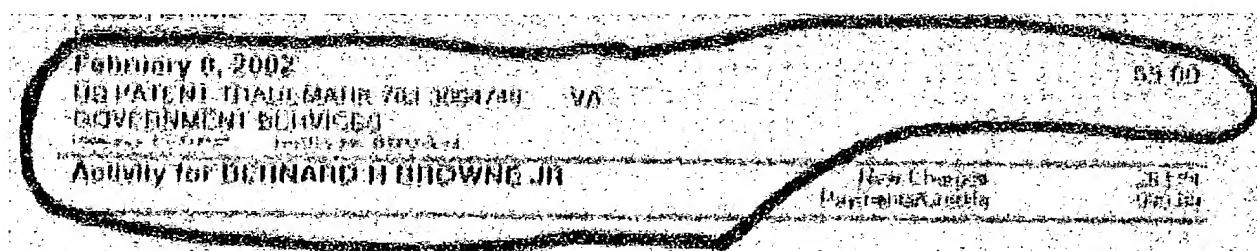


Figure 6 - Late Fee Requested and Transmitted to USPTO on February 8, 2002.

Because we had met the required response date for the "Final" action by mailing our final response on December 24, 2001 (Figure 2 - item 6), we feel that this fee should be refunded because we were not late with our reply to the "final" office action request.

### 3.3.6 Another Amendment Was Not Untimely Filed on May 3, 2002

No, we amended our application on May 23, 2001 in response to the USPTO's January 24, 2001 action item requesting more detail on our patent application. We mailed the amendment with the additional detail requested on May 16, 2001 well within the 30 day extension we also requested for this response.

However, on May 3, 2002, applicant responded with another amendment, but did not further extend the period for reply. This amendment was not considered by the examiner because it was not timely filed.

#### **USPTO Decision Statement 6**

The item mailed on May 3, 2002 was a response to the USPTO advisory item mailed on Feb. 13, 2002 which simply wanted us to mark up our amended application in accordance with 37 CFR 1.121 within a 3 month period of our "final" rejection (see Figure 5). However, since this item was mailed after the due date of our final response, it could only be logically concluded that we had 3 months from the advisory action mailing date since going backwards in time to January 4, 2002 was not possible!

Moreover, we would have very easily complied with 37 CFR 1.121 much, much earlier had we been advised with any reasonable timing rather than almost of 9 months after we filed our amended application with more detail (Figure 2 - item 4). Instead, we were advised to comply with the 37 CFR 1.121 amendment marking procedure more than a month after the "Final" response due date!

### 3.3.7 Application Was Not Abandoned Effective February 5, 2002.

Absolutely not! The inventor mailed the response to the "final" office action on 12/24/01. At no time did the inventor abandon any aspect of this application! The USPTO

No proper reply having been timely received and no further extensions of time obtained, the application became abandoned effective February 5, 2002.

#### **USPTO Decision Statement 7**

called the inventor on 2/08/02 requesting a late fee which was paid on this date (Figure 2 - item 7). Since we were not late responding to the "Final" action, we could only conclude that there was something forthcoming which needed a time extension for compliance. Sure enough, we received an advisory action on 2/13/02 requiring a 3 month reply form the "Final" action which had already passed. Therefore, with both a late fee paid for not being late and with 3 month timing stated on the advisory action, it could only be logically

concluded that May 13, 2002 was the new due date for complying with 37 CFR 1.121 as was requested in the 2/13/02 advisory action.

### 3.3.8 Notice of Abandonment Mailing Date Error

No, the USPTO notice of abandonment was mailed on 5/23/02, not on 5/3/02 as stated. Furthermore, the inventor never had any intention of abandoning any aspect of this invention.

A Notice of Abandonment was mailed on May 3, 2002.

#### **USPTO Decision Statement 8**

### 3.3.9 Petitioner Maintaining that the Delay Was Unavoidable Was Not Strictly Correct

No, the petitioner provided a choice to the USPTO that the delay was either unavoidable OR

unintentional and that the USPTO would accept one or the other. Checks were cashed by the USPTO for both options which was not the action intended by the inventor.

Petitioner maintains that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unavoidable.

#### **USPTO Decision Statement 9**

Further, meeting the January 4, 2002 deadline in the advisory action mailed by the USPTO on 2/13/02 was more than unavoidable, it was impossible!

### 3.3.10 Petitioner Logically Believed New Period Was Set For Final Response

This decision statement is correct and is the only logical conclusion that could ever have been made. For example, could the inventor have turned back the clock more than a month earlier in order to properly respond to the February 13, 2002 USPTO advisory action??? Because of this reverse timing

Pro se applicant Browne appears to be making the following arguments to show unavoidable delay:  
1. Applicant believed the Advisory Action mailed February 13, 2002 which stated that the period for reply expires 3 months from the mailing date of the Final Rejection, set a new period for reply because it was mailed more than 3 months after the final Rejection. Thus, petitioner thought the filing of their response on May 3, 2002 was timely (Para. 2.3.1- 2.3.2);

#### **USPTO Decision Statement 10**

situation and because 209 pages of material had to be furnished to comply with the advisory

action requesting compliance with 37 CFR 1.121, there was no other logical conclusion that could have been made. Furthermore, why was the request for compliance with 37 CFR 1.121 mailed after the “final” response due date had passed when our amendment providing the additional detail requested by the USPTO was mailed a year earlier on May 23, 2001 (Figure 1 - item 4)?

### 3.3.11 Advisory Action on New Rule Mailed Almost Nine Months After Amendment Filed

The additional detail requested by the USPTO on 01/24/01 required the inventor to provide a very large amendment which was filed on 5/23/01 (with one month extension). Since there was no advisory action on this massive amendment dealing with the marking up format of 37 CFR 1.121 until approximately nine months later and over a month after the “final” action, it was only logically concluded that new rules on amendments became effective after our initial patent application was filed on August 31, 2000. Otherwise, why did the USPTO wait almost nine months to request compliance with 37 CFR 1.121 on the amendment? Why wasn’t the advisory action mailed sooner so the inventor could have responded sooner instead of waiting until after the “final” action date?

Pro se applicant Browne appears to be making the following arguments to show unavoidable delay:

2. An additional three months from the mailing date of the Advisory Action was needed to comply with the action, as the action required applicant to make the amendment mailed May 23, 2001 comply with the provisions of 37 CFR 1.121. This additional time is warranted as the amendment was mailed more than 3 months before the new patent rule became effective August 2001, and the amendment complied with the rules in effect when it was filed (Para.2.3.3);

#### **USPTO Decision Statement 11**

### 3.3.12 Late Fee Requested by USPTO When Nothing Was Late

The inventor has complied in a timely manner to all USPTO action requests except the February 13, 2002 item that required turning the clocks back. The inventor even complied in a very timely manner with a request for a late fee that was requested by a USPTO employee on

Pro se applicant Browne appears to be making the following arguments to show unavoidable delay:

3. A telephone request for payment of a \$55 extension fee from a USPTO employee on February 8, 2002, coupled receipt of the Advisory Action mailed February 13, 2002 about a week later, confirmed for applicant that the period for reply ran three (3) months from the mailing date of the Advisory Action (Para. 2.3.4);

#### **USPTO Decision Statement 12**

02/08/02 even though nothing was filed late. Nothing was late relative to the “final” action because it was mailed on December 24, 2001 (figure 3) and it wasn’t due until January 4, 2002. However, when the advisory action was received about a week after the USPTO mailing date of 2/13/02 requesting compliance on 37 CFR 1.121 within three months of the “final” action date (01/04/02), it was logically concluded that since we couldn’t go backwards in time that the late fee requested was to cover the 3 month extension of time granted until May 4, 2002. What other logical conclusion could have been drawn?

### 3.3.13 Absolute Proof On Mailing Delays

We were absolutely correct on stating that there were mailing delays. Figure 3 shows our 12/24/2001 certified mail receipt and Figure 4 shows 01/15/02 as the date the item was received. This proves that there was a 22 day mailing time associated with the “final” action which is an extraordinary mailing delay. Whatever the reason(s), the delay was tremendous and we have proven it without any doubt whatsoever!

Pro se applicant Browne appears to be making the following arguments to show unavoidable delay:

4. Response times were shortened over previous years of such mailings due to extraordinary delays during this period caused by 9/11/01 attacks on the World Trade Center and Pentagon, anthrax contamination in mail stations and Christmas mailing loads (Para. 2.3.5).

### **USPTO Decision Statement 13**

## **3.4 Comments on STATUES, RULES AND REGULATIONS Section of USPTO**

**Oct, 3, 2002 Letter**

### 3.4.1 Replies to All Outstanding Office Actions Were Filed

The inventor has properly responded to all outstanding USPTO actions and notices in a timely manner. See Table 1 attached for a complete summary of all actions to date.

Also shown in Table 1 are differences in dates between actual mailing dates by the inventor and dates erroneously stated by the USPTO.

35 U.S.C. §133 provides that the Commissioner may revive an application if the delay in replying to the outstanding Office action is shown to the satisfaction of the Commissioner to have been unavoidable. A grantable petition to revive an unavoidably abandoned application under 37 CFR §1.137(a) must be accompanied by:

(1) the reply required to the outstanding Office action or notice, unless previously filed;

### **USPTO Decision Statement 14**

### 3.4.2 Petition Fee Set Forth in 37 CFR §1.17 (1) Was Paid

Per 37 CFR 1.17 (1), a petition fee of \$55.00 for a small entity was paid by the inventor. The fee was paid from the inventor's small business checking account of **Byte Masters International** (check number 2236).

The inventor's small business, **Byte Masters International**, was formed when the inventor was laid off from a defense contractor at the end of the cold war and is now a self-publishing company for the author's books — three books so far with the last two *America Online and Best Web Sites* books being carried by many distributors and nationwide in Barnes and Noble stores.

A grantable petition to revive an unavoidably abandoned application under 37 CFR §1.137(a) must be accompanied by:

(2) the petition fee set forth in 37 CFR §1.17(1);

### **USPTO Decision Statement 15**

### 3.4.3 Entire Delay Was Unavoidable

As pointed out previously, the delay was totally unavoidable and the delay only could have been avoided if we were able to reverse time or had the USPTO advised us sooner on the need for new rule 37 CFR 1.121 compliance. Since we filed our amendment with the additional detail requested on 5/23/01, we would have had plenty of time to comply if the USPTO had advised us sooner than 2/13/02.

A grantable petition to revive an unavoidably abandoned application under 37 CFR §1.137(a) must be accompanied by:

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable;

### **USPTO Decision Statement 16**

### 3.4.4 Disclaimer and Fee Not Required

As this utility application was filed after June 8, 1995, no terminal disclaimer is required and since no

aspect of the application is now disputed with the USPTO except the timing issue (which we feel is totally in our favor), no terminal disclaimer statement is hereby made. However, a \$55.00 fee is enclosed. This check, however, in no way should be construed as implying any type of disclaimer on any aspect of our patent application.

A grantable petition to revive an unavoidably abandoned application under 37 CFR §1.137(a) must be accompanied by:

(4) any terminal disclaimer (and fee as set forth in §1.20(d))

### **USPTO Decision Statement 17**

### 3.4.5 Burden of Proof Upon Inventor

This inventor has accepted this responsibility of showing the cause of delay and has proven the delay was unavoidable since it was not possible to turn back the clock in order to respond to the USPTO 2/13/02 advisory action

before 01/04/02. Furthermore, we have proven with solid evidence that the USPTO's statements pertaining to timing in paragraphs 3.3.1, 3.3.2, 3.3.3, 3.3.4, 3.3.5, 3.3.6 and 3.3.7 were incorrect and that our responses have been timely given the communications that were exchanged.

The burden of showing the cause of the delay is on the person seeking to revive the application. *Smith v. Mossinchoff*, 671 F.2d 533,538, 213 U.S.P.Q. 977, 982 (D.C. Cir.1982) . This burden includes establishing that the entire delay from the due date for the reply until the filing of a grantable petition was unavoidable. *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 U.S.P.Q.2d 1130, 1131-32 (N.D. Ind. 1987).

### **USPTO Decision Statement 18**

### 3.4.6 No More or Greater Care or Diligence than Is Generally Used and Observed by Prudent and Careful Men in Relation to Their Most Important Business.

This inventor's *most important business* since having his employment in the defense industry terminated several years ago at the end of the cold war is writing and publishing books (see Figure 7), not filing patents. Further, the inventor has had to cope with employment hardships since his job in the defense industry was terminated. His background in the defense industry was in synthesizing and analyzing inertial navigation systems, missile guidance systems and advanced sophisticated weapons systems, not filing patents, and it has been impossible to apply this background to non-defense contractor activities.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the "reasonably prudent person standard" in determining if the delay was unavoidable. The word 'unavoidable' is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.

### **USPTO Decision Statement 19**



Figure 7 - Inventor's Most Important Business

Further, this whole patent filing and subsequent follow up has delayed his writing and publishing his next book and we are very anxious to finally wrap this patent activity up once and for all without anymore disputes with the USPTO over an very small timing issue that was really caused by the USPTO itself! We really deserve this wonderful patent finally completed.

### 3.4.7 Unforeseen Fault Did Occur Making the Minor Delay Unavoidable

There indeed were faults or imperfections of agencies and instrumentalities involved in the timing process, or else it wouldn't have required the clock to be turned back in order to meet the timing requirements of the

February 13, 2002 advisory action. And this was over eight months after the large

amendment providing the additional detailed requested was filed. Plus new rules were effect which took place after the inventor first applied for the patent. Assuming even if filing patents or music technology was the most important business of the inventor (which it is not), we have proven without a doubt that there has been fault or imperfection of government agencies involved. These faults or errors were likely directly or indirectly caused by both the rule changes that took place during this period and the mailing delays associated with the 9/11 World Trade Center, the Pentagon disaster, mail room anthrax and Christmas and New Year holiday personnel off times. In any event, the number of incorrect timing judgements made by the USPTO pertaining to this timing matter were horrendous and have significantly delayed wrapping up this patent!

It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

### **USPTO Decision Statement 20**

Faults in documenting correct dates on the part of the USPTO have been shown in paragraphs 3.3.1, 3.3.2, 3.3.3, 3.3.4, 3.3.5, 3.3.6 and 3.3.7. Further, sending out an advisory to comply with 37 CFR 1.121 within 3 months of the Oct. 4, 2001 "final" action more than a month after the final action due date of January 4, 2002 made a timely response only possible by reversing the clocks which, of course, made our response unavoidably late.

### 3.4.8 Burden of Establishing That the Delay Was "Unavoidable" Has Been Met

In reference to USPTO statements 21, the burden of establishing that the delay was unavoidable has been met. The forgoing paragraphs have established extremely well that the delay has been "Unavoidable" due to untimely advisories and incorrect judgements on the inventor's timing by the USPTO as well as unacknowledged mailing delays. Paragraphs ahead will continue to address timing issues.

In re Mattullath 38App. D.C. 497, 514-15 (1912) (quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 U.S.P.O. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.O. 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith*, 671 F. 2d at 538, 213 U.S.P.O. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines*, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

#### **USPTO Decision Statement 21**

### 3.4.9 Delays Were Due to Delayed Advisory Actions, Timing Assessment Errors and Mailing Delays

There was no lack of knowledge or improper application of the patent statute, or improper rules of practice conducted here on the part of the inventor. It has been proven without a doubt that the delay claimed was due to improper timing judgements on the part of the USPTO and by the impossibility of reversing the clock to meet timing requirements specified that was impossible to meet otherwise.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute unavoidable delay. See *Haines*, 673 F. Supp. At 317, 5 U.S.P.Q. 2d at 1132S; *Vincent v. Mossinghoff*, 230 U.S.P.Q. 621, 624, (D.D.C. 1985); *Smith v. Diamond*, 209 U.S.P.Q. 1091 (D. D. C. 1981); *Potter v. Dann*, 201 U.S.P.Q. 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). (Cf. *In re Decision dated February 18 1969*, 162 U.S.P.Q. 383 (Comm'r Pat. 1969; interpretation of rule 7 was not unreasonable; hence resultant delay in prosecution may be considered unavoidable).

#### **USPTO Decision Statement 22**

### 3.4.10 Timing Not Due to Oral Advice Nor Due To Failure To Advise in Timely Fashion

There is no claim here that there was any part (A) contributing to what has been claimed an inventor's delay. However, a USPTO employee did call the inventor on 2/08/02 after the final response deadline to ask for a "late fee" even though the inventor responded on Dec. 24, 2001 within the "final" response period which had a deadline of Jan. 4, 2002.

Furthermore, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from USPTO employees; or (B) the USPTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

#### **USPTO Decision Statement 23**

Part (B) of this timing point in USPTO statement 23 is also not applicable because the advisory action mailed on 2/13/02 was sufficiently after the deadline for the "final" action response due date. The 10/04/01 action on the part of the USPTO therefore was not actually the final action date as claimed, or else the USPTO advisory action mailed on 2/13/02 would not have had the box checked reading: "The period for reply expires 3 months from the date of the final rejection" (see figure 5). It could only be implied that this statement gave rise to a new final due date which was 3 months from 2/13/02 or 5/13/02 which, of course, was met by the inventor's 5/03/02 mailing satisfying the advisory action relative to 37 CFR 1.121. And rule 37 CFR 1.121 was not in effect when the book author inventor filed his patent application on August 31, 2000. After August 31, the inventor only had cause to respond to advisory actions of the USPTO — which he did in a timely fashion!

### 3.4.11 Filed Were Petitions Pursuant to 37 CFR 1.137 (a) OR 37 CFR 1.137 (b)

The inventor feels strongly that the timing issue raised by the USPTO was unavoidable per 37 CFR 1.137 (a). However, to insure that the petition was accepted on a most timely basis, the inventor also filed a petition under 37 CFR 1.137 (b) with the stipulation that

the USPTO accept (a), or if not, accept (b). He just wanted to be sure of overcoming the minor timing matter either way that suited the USPTO — unavoidable **OR** unintentional. Yet, the USPTO accepted neither alternative in our August 7, 2002 petition while keeping the fees for both which is quite puzzling to this small entity entrepreneur.

One who cannot show unavoidable delay is not precluded from obtaining relief by filing a petition pursuant to 37 CFR § 1.137(b) on the basis of unintentional delay.

#### **USPTO Decision Statement 24**

### 3.4.12 Replies to All Outstanding Office Actions Were Filed

As pointed out in paragraph 3.3.15, all required replies to USPTO actions and/or notices have been filed. Table 1 attached lists all USPTO actions, the inventor's responses and the USPTO's stated dates on the inventor's actions.

Figures 1 and 2 also attached depict all actions graphically.

A grantable petition under § 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed;

### **USPTO Decision Statement 25**

### 3.4.13 A \$640.00 Fee for Reviving Patient Was Paid.

As explained in paragraph 3.3.1, the inventor has paid fees for both an unavoidable delay AND an unintentional delay even though the inventor feels strongly that the delay was unavoidable — unless we could have turned back the clock, of course! The amount paid per 35 U.S.C. 41(a)(7) (§ 1.137(b)) was \$640.00.

A grantable petition under § 1.137(b) must be accompanied by: (2) the petition fee set forth in 37 CFR § 1.17(m);

### **USPTO Decision Statement 26**

The inventor by no means intended for both checks to be cashed — \$55.00 (check #2236 for unavoidable) and \$640.00 (check #2237 for unintentional) — but rather intended that the USPTO would accept one OR the other but not both.

### 3.4.14 Statement that Delay Was Unintentional Was Made As Well As Unavoidable

The inventor not only stated that the entire delay was unintentional, but he also stated that stated in the August 7, 2002 mailing (Item 16) that it was strongly felt that the contended delay was really unavoidable. The inventor also stated that if the USPTO disagreed with the inventor about the delay being unavoidable, then he requested that the USPTO accept the claim that the delay was unintentional (paragraph 3.3, item 16, 8/07/02). Proof on the timing was provided in an attachment to item 16.

A grantable petition under § 1.137(b) must be accompanied by: (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;

### **USPTO Decision Statement 27**

### 3.4.15 No Terminal Disclaimer Required

As was the case stated in paragraph 3.4.4, no aspect of the application is now disputed with the USPTO except the timing issue (which we know is in our favor). Therefore, no terminal disclaimer statement is hereby made.

However, a \$55.00 fee is enclosed. However, this check in no way should be construed as implying any type of disclaimer on any aspect of our patent application. The \$55.00 is the fee for reprocessing this petition.

A grantable petition under § 1.137(b) must be accompanied by:(4) any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to §1.137(d).

### **USPTO Decision Statement 28**

### **3.5 Comments on ANALYSIS Section of USPTO Oct, 3, 2002 Letter**

#### 3.5.1 Showing of Unavoidable Delay Within Meaning of §1.137(a)

No, this is not correct. The petitioner has made it extremely clear that the delay was

Petitioner has neither made an adequate showing of unavoidable delay nor submitted the required reply, within the meaning of §1.137(a).

### **USPTO Decision Statement 29**

unavoidable and has pointed out timing errors on the part of the USPTO. The advisory action requesting compliance with 37 CFR 1.121 before the final due date of 1/04/02 was mailed by USPTO on 2/13/02. This was more than a month past the due date of the final action due date of 01/04/02. Further, the USPTO was wrong in stating that our amendment in compliance with the final action was mailed on 01/15/02. Our large amendment was mailed on 12/24/01. See figure 3 which shows our certified mail receipt date of 12/24/01 for the material provided in response to the USPTO final action request.

Also, there was advisory action mailed on 2/13/02 requesting that our amendment filed 01/15/02 (really 12/24/01) did not comply with 37 CFR 1.121. Since this was after the fact and there was no way to turn back the clock, the delay in complying with 37 CFR 1.121 certainly was unavoidable. Further, there were only minor wording changes in the claims in our 12/24/01 response to the final USPTO action.

Further, a major amendment to the patent application was made on 05/23/01 in response to the USPTO's request for more detail on our patent. Yet, a request for compliance with 37 CFR 1.121 was made almost eight months later. If the USPTO had notified us with an advisory action anytime before the final due date, we certainly would have responded in a timely manner.

### 3.5.2 Advisory Action Was Mailed After Final Rejection Due Date and Almost Eight Months After A Major Amendment

It is understood that advisory actions cannot extend periods for replies to final rejections if the advisory action was mailed (and received) before the date of the final rejection. However, in this case, the advisory action in question (Item 8, mailed 2/13/02)

The explanations set forth by petitioner for the delay in replying reflect a misunderstanding of the patent rules. The rules make clear that an advisory action cannot extend the period for reply to an outstanding final rejection.

#### **USPTO Decision Statement 30**

was mailed after the final action due date of 01/04/02. Further, a major amendment was filed by the inventor on 5/23/01 in response to a request for more detail requested by the USPTO on 1/24/01, and therefore there were many months where the USPTO could have provided an advisory action advising the inventor that compliance with 37 CFR 1.121 was now required. Instead, the USPTO mailed the advisory action on 2/13/02 more than a month after the final action due date.

### 3.5.3 Period For Replying to Final Action Was Less Than Three Months

The inventor complied with the requirement for responding to the “final rejection” within a three month time period. The final action was mailed by the USPTO on 10/04/01 and the inventor responded

with all items requested on 12/24/01. There is a copy of the certified mail receipt proving this in Figure 3. The “final action” of the USPTO (Item 5)

The period or reply to a final rejection is set by statute to extend for a maximum of six months. As a statutory requirement cannot be waived, in no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of a final rejection. See 35 USC 37 CFR 1.136(a); MPEP 706.07(f).

#### **USPTO Decision Statement 31**

requested justification that new material was not added in our 5/23/01 amendment and detail was wanted on how our patent was different than material in patents by Sato, Farrand, etc. The inventor’s response to the “final action” (Item 6) was mailed 12/24/01.

### 3.5.4 Telephone Call For Late Fee Was Confusing Because Our Reply Wasn't Late

The inventor is a small entity business owner with experience only in the book authoring and publishing field the last few years, and when the USPTO called and asked for a late fee when our final response (12/04/01) wasn't late, this indeed was confusing. It was very confusing because absolutely nothing was late on the date that the USPTO employee called and asked for a late fee!

Had applicant understood these rules, the telephone call from the USPTO would not have further confused him.

#### **USPTO Decision Statement 32**

### 3.5.5 Going Backward in Time Was Not Possible

Unless the USPTO has found a way to go backwards in time, mailing the response to the advisory action was not possible. The mailing date on the part of the USPTO for the "final rejection" (item 5) was 10/04/01. The inventor responded to this request on 12/24/01 with the detail requested in item 6 (see Figure 2

Furthermore, petitioner's misapplication of the rules is not reasonable given the clear language of the advisory action. Under the heading "PERIOD FOR REPLY" the advisory action, stated that "the period for reply expires 3 months from the mailing date of the final rejection," not 3 months from the mailing date of the advisory action.

#### **USPTO Decision Statement 33**

and Table 1). This response on the part of the inventor was well within the three months requested although the USPTO has erroneously stated that we responded late to the final action item on 01/15/02 and even requested a late fee from us on 2/08/02.

Then, mysteriously, more than a month after the final item due date of 01/04/02, an advisory action was mailed by the USPTO on 2/13/02 stating that our amendment filed on "1/15/02" did not comply with 37 CFR 1.121. Well, since we couldn't go back in time, the only logical conclusion by any person of any background was that a new response period of three months had been established. This therefore set the due date for complying the 37 CFR 1.121 three months from 2/13/02 which would be 5/13/02. This due date was met by the inventor's item 9 mailed on 5/03/02.

Even more mysterious was why the USPTO waited over eight months to inform us that we must comply with 37 CFR 1.121. Our large patent amendment with the additional detail requested by the USPTO was mailed 5/23/01.

### 3.5.6 Distinction Between Final Rejection and an Advisory Action Was Very Clear

The distinction between an advisory action and a final rejection was and is very clear to the inventor. What is not clear is why the USPTO did not advise the inventor before the final due date on the need to comply with the new rule 37 CFR 1.121 which came into effect after the initial patent filing. Instead the USPTO sent the advisory action more than a month after the final action due date and over eight months after the inventor sent in a major amendment on 5/23/01. If the inventor couldn't turn back the clock to a point before the final due date, why was the 2/13/02 advisory action sent when it was?

Curiously, petitioner cites on petition this very language. This again reflects his lack of knowledge of the patent rules and his confusion regarding the distinction between a final rejection and an advisory action.

### **USPTO Decision Statement 34**

### 3.5.7 Inventor Complied With Rules That Were in Effect at the Time the Patent was Filed

Granted, since the inventor is not a patent attorney, he wasn't exactly right in assuming that 37 CFR 1.121 became effective in August 2001. It turns out that a revised edition of the MPEP was published at that time.

However, point out that the new rule 37 CFR 1.121

relating to how to mark up amendments was set forth in the Federal Register on September 8, 2000 which was a week after the invention was first filed on 8/31/00.

Petitioner is also inaccurate in his conclusion that 37 CFR 1.121 was effective August 2001. Rather, August 2001 was the month in which a revised edition of the MPEP was published. The revision to the rule was set forth in the Federal Register on September 8, 2000, and became effective November 7, 2000. [revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (i) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001. Thus, an additional period for reply was not warranted

### **USPTO Decision Statement 35**

Since the inventor is a former cold war systems engineer currently trying to provide an income by book authoring and publishing, there was no time or any known reason to keep abreast of patent rule changes during our post 8/31/00 patent application date other than what the USPTO would advise him to do after the initial filing. And the changes did occur after our initial filing. Unfortunately, the advisory action (item 8) wasn't sent to the inventor until many months after his major amendment was filed on 5/23/01. In fact, the advisory action was so untimely that it was sent after the "final" action due date. Considering this horrible timing on the part of the USPTO (post final due date), an additional period for the inventor's response was certainly warranted by even the strictest standards.

It should be noted that the inventor has complied with all outstanding USPTO actions in a timely manner, whereas the USPTO was late with their last advisory action and very wrong on their perception of dates involved on many of the inventor's action dates.

### 3.5.8 Inventor and USPTO Caught Between Changing Rules Causing Delays

If 37 CFR 1.121 would have been in effect at the time the initial patent was filed or if the USPTO would have informed the inventor in a more timely manner instead of after the fact, our amended patent application filed on 5/23/01

The amendment when filed should have been in compliance with 37 CFR 1.121.

certainly would have been in compliance with 37 CFR 1.121. We suspect that the USPTO office was adjusting to the new patent rules or else the advisory action that wanted us to comply with 37 CFR 1.121 would have been sent to the inventor months earlier rather than being sent after the "final action" due date of 01/04/02. And within 3 months of being informed of the need to comply with 37 CFR 1.121, the inventor did comply by responding with 209 pages of marked up and clean patent material pertinent to 37 CFR 1.121's requirements. This wasn't exactly as simple as say patenting a new type of paper clip!

### **USPTO Decision Statement 36**

### 3.5.9 Delays Definitely Affected Timing and We Have Proof

Arguments for shortened response time not well taken? Not only were the events of 9/11/01 and anthrax mail room contamination factors, but the final 3 month response period also included Christmas and New Years! To prove this point, it is noted on our certified mailing receipt (Figure 3) that our final response was mailed on December 24, 2001.

Yet, the USPTO had claimed that

this item was sent on January 15, 2002. This is a 22 day error in the assessment of the inventor's timing on the part of the USPTO which favors the inventor. Certainly events of 9/11/01, anthrax contamination and holiday off time on the part of USPTO employees contributed to this misjudgement in timing on the part of the USPTO and certainly had something to do with the USPTO mailing an advisory action more than a month after the final action due date and more than eight months after our significantly amended application with the additional detailed requested was filed on May 23, 2001.

Regarding his argument that the response time was shortened due to various extraordinary events, this argument is also not well taken. Of course, the Office is cognizant of the delays attributable to the events of September 11, 2001, as well as, those related to the anthrax contamination. The Office has set forth many new policies to account for these delays. Many of which were specifically directed to *pro se* applicants. However, petitioner has not shown that his delay is explained by these extraordinary events.

### **USPTO Decision Statement 37**

Also very not true by any standards is the comment in the USPTO decision statement 37 that “The Office has set forth many new policies to account for these delays.” First of all, the 10/04/01 “final” action by the USPTO called for a “Shortened Statutory Period for replying of 3 months.” This obviously was no new policy to account for delays occurring. Secondly, the USPTO charged the inventor a late fee for his “final” response even though it wasn’t late. And finally, the USPTO asked the inventor to respond to an action item backwards in time in the 2/13/02 advisory which was due on 1/04/02!

### 3.5.10 Going Backward in Time Apparently Was Required

Yes, the petitioner does acknowledge a misunderstanding of the date of expiration of the advisory action response period because he didn’t believe he could turn back his clock. Instead of 3 months from the advisory action

mailing date of 2/13/02 putting the response date at 5/13/02, the inventor should apparently have turned back the clock so he could have filed the response to the advisory action before 01/04/02 which was the “final response” deadline. Of course, not really being able to do this, the inventor could only conclude that the 3 month period stated on the USPTO 2/13/02 advisory action was relative to 2/13/02 putting the response deadline at 5/13/02 which was met by the inventor by his 5/03/02 mailing (item 9).

First of all, petitioner acknowledges as a cause of the delay his misunderstanding of the date of expiration of the response period.

### **USPTO Decision Statement 38**

### 3.5.11 Petitioner Had No Delays Associated With 2001 Events But USPTO Did

We argue this point by claiming that we had no delays due to 2001 events although it is obvious that the USPTO had considerable delays in receiving their mail and responding in a timely manner. The primary example of this is the USPTO’s statement that our response to the “final action” was sent 01/15/02 whereas we have

proved that it was sent on 12/24/01. Mailing our response to the USPTO’s “final action” on 12/24/01 made our response to the “final” action timely, and not late!

Secondly, petitioner does not establish a nexus between his delay and the extraordinary events of 2001. Petitioner does not show how these events caused a delay in filing a reply. Petitioner does not show that the October 4, 2001 Office action was received with less than a month remaining in the period for reply due to delays in mailing.

### **USPTO Decision Statement 39**

### 3.5.12 Burden of Showing Delay Was Unavoidable Was Met — Unless We Were Required to Turn Back the Clock

Again, we can only say that the only way we could have met the timing requirements of the “post final action” advisory action (item 8) was to set back the clock. If this can’t be considered unavoidable, we sure would like to see some cases where this has been done.

We don’t believe there would be a single case on this planet.

Petitioner's arguments and evidence have been considered and it is concluded that petitioner has not met his burden of showing that the delay was unavoidable.

**USPTO Decision Statement 40**

### 3.5.13 Amendment Was Filed May 23, 2001, Not on May 3, 2002

As previously noted several times, the inventor amended his application on May 23, 2001 (item 4) in order to provide the additional patent detail requested by the USPTO on 1/24/01 (item 2). The advisory action mailed on 2/13/02 noted that the amendment did not comply with the new marking up procedure now required

under 37 CFR 1.121. Had this advisory action been mailed any reasonable time before the “final action” date, the inventor would certainly have responded in a timely fashion. All previous inventor required actions have been filed on time or made to be on time with appropriate time extension fees.

In addition, on petition, petitioner notes the amendment previously submitted May 3, 2002, as his reply under § 1.137 (a) (3). A proper reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law), (2) an amendment that prima facie places the application in condition for allowance, (3) the filing of a continuing application (4) a request for continuing examination under § 1.114, or (5) if applicable, a § 1.129(a) submission. The previously submitted amendment has been determined by the examiner not to place the application in condition for allowance.

**USPTO Decision Statement 41**

Further, the item filed 5/03/02 was not an amendment of any type affecting the functional characteristics of the invention, but rather simply a marking up procedure to show the changes and additions that were submitted in the 5/23/01 amended patent application and the minor wording changes in some claims in response to the 10/04/01 final action request. No functional changes were made or detail added since the 5/23/01 amended application was filed.

### 3.5.14 Proper Reply Satisfying § 1.137(a) Was Made in Petition

After further reviewing all actions and noting the many erroneous dates documented by the USPTO, it is now most strongly felt that our petition filed on August 7, 2002 in accordance with

37 CFR 1.137 (a) was proper and should have been accepted. Perhaps our petition was not seriously taken because all the focus was on the actions of the inventor without focusing on the USPTO's errors which had made a timely response impossible.

Accordingly, it is concluded that a proper reply is still required to satisfy § 1.137(a).

#### **USPTO Decision Statement 42**

Items previously provided in our effort to satisfy the requirements of § 1.137(a) included:

1. Proof that all replies all outstanding USPTO office actions have been provided including the 209 pages of material required to satisfy the requirements of the "final office action."
2. A petition fee of \$55.00 in compliance with 37 CFR 1.17(1).

#### **3 Showing That Delay Was *Unavoidable***

Of course, the arguments provided in item 3 were not accepted which is the reason we have responded with more detail showing that our petition showing an unavoidable delay should have been accepted. We trust that the USPTO will reconsider our case and finally complete this lengthy application so the inventor can get back to writing books. This patent application, incidentally, has taken so much time and paper work that the author/inventor's 4<sup>th</sup> book will be a "how to book" involving patent applications and will use this complicated application as its example. If there are any reasons why the USPTO objects to use of this application in any way being used in our next book, please let us know. As a professional courtesy, we will not name any USPTO employees in the book unless requested to do so.

### 3.5.15 Petitioner Requested Revival Under One or Another — Not Both (a) AND (b)

As stated in paragraph 3.4.11, the inventor feels strongly that the timing issue raised by the USPTO was unavoidable per 37

Petitioner has also requested revival under § 1.137(b)

#### **USPTO Decision Statement 43**

CFR 1.137 (a). However, to insure that the petition was accepted on a most timely basis, the inventor also filed a petition under 37 CFR 1.137 (b) with the stipulation that the USPTO accept (a), or if not, accept (b).

We just wanted to be sure of overcoming the minor time dispute either way — unavoidable **OR** unintentional. Yet, the USPTO accepted neither which is quite puzzling, particularly when fees for both (a) and (b) were both cashed by the USPTO. In this petition, we unfortunately had to point out the errors made by the USPTO in assessing our timing which we didn't address with any strength in the previous petitions.

### 3.5.16 Petitioner Did Reply to the Final Office Action and All Other Officer Actions

No, the statement here is not correct. The petitioner did reply to the final office action as well as all other office actions and advisories which makes this statement quite puzzling. The response to the final office action was mailed 12/24/02 (Item 6 - Figure 2). Figure 3 shows our certified mail receipt and figure 4 shows the return mail receipt showing that the final office action material was received by the USPTO on 01/15/02. The final office action requested a reply to what appeared to be new material in our amended specification, claims, drawings; and reasons why our application didn't infringe upon patents of Sato, Farrand, Goede, Miyano and Eller. Twenty-four pages of material was provided to USPTO as requested including: proof that new functional material was not added in the 05/23/01 amendment plus minor corrections to claims and reasons why our application didn't infringe upon the inventors' material mentioned.

The standard for showing that the delay unintentional under § 1.137(b) is less exacting. Petitioner has included a statement of unintentional delay which satisfies this requirement. In addition, petitioner has paid the petition fee for consideration under § 1.137(b). As this utility application was filed after June 8, 1995, no terminal disclaimer is required. Nonetheless, the petition is not grantable under § 1.137(b). Revival under § 1.137(b) also requires submission of a proper reply to the final Office action, as described above. As petitioner has not submitted this reply, the petition under § 1.137(b) must also be dismissed.

#### **USPTO Decision Statement 44**

The petitioner also replied to the "post-final" action (item 8 - Figure 2) mailed by the USPTO on 2/13/02. The 209 page response was mailed by the petitioner on 5/03/02.

Sincerely,



Bernard H. Browne, Jr. - Inventor

Author/Publisher of *America Online and Best Web Sites* book series

**Attachments:** Table 1 Summary of all communications with Patent Office.

Figure 1 Graphical Depiction of communications (Aug. 2000 to Sept. 2001).

Figure 2 Graphical depiction of communication (Oct. 2001 to Nov. 2002).

Check # 2241 for \$55.00

**Table 1****SUMMARY OF ALL OFFICE ACTIONS/COMMUNICATIONS ON APPLICATION 09/655792***"INSTANT MUSICIAN, RECORDING ARTIST AND COMPOSER"*

by Bernard H. Browne, Jr.

<b>A. Action Item No.</b>	<b>B. USPTO Action Date</b>	<b>C. Inventor Action Date</b>	<b>D. USPTO Stated Date on Inventor's Action</b>	<b>E. Action Description</b>
1.		8/31/00	8/31/00	Initial patent application
<b>Rewards to Rules in the Federal Register on September 8, 2000</b>				
2.	1/24/01			3 month reply requested for more specification detail, modification of claim(s) and comments on possible similar material in the patents of Sitrick, Aoki, et al.
3.		04/16/01		30 day extension requested along with \$55.00 paid via check.
4.		5/23/01	5/29/01	<b>Amended application</b> provided as requested in action item 2 including more detailed specification (7 pages increased to 29 pages), more drawings (11 drawings increased to 28 drawings), more detailed claims (1 multi part claim amended to 17 comprehensive claims) and well documented reasons why our patent application was different from the material in the patents of Sitrick, Aoki, et al.
5.	10/04/01			"Final Action" with 3 month reply requested relating to what appeared to be new material in our amended specification, claims, drawings; and reasons why our application didn't infringe upon patents of Sato, Farrand, Goede, Miyano and Eller.
6.		12/24/01	1/15/02	Material provided to USPTO as requested including: proof that new functional material was not added in the 05/23/01 amendment, corrections to claims and reasons why our application didn't infringe upon the inventors' material referenced above.
6a.	2/08/02			Trina at Patent Office called inventor on phone and requested a late fee of \$55.00. It was not explained what the fee covered.
7.		2/08/02	1/15/02	Inventor FAXed Trina at the Patent Office authorizing a \$55.00 charge to inventor's American Express account.

A. Action Item No.	B. USPTO Action Date	C. Inventor Action Date	D. USPTO Stated Date on Inventor's Action	E. Action Description
8.	2/13/02 <b>(Final action was due 1/04/02)</b>			Advisory action stating that the "amendment" filed on "1/15/02" did not comply with Rule 37 CFR 1.121. It was documented that "The period for reply expires 3 months from the mailing date of the final rejection."
9.		5/03/02	5/03/02	209 pages of patent material mailed complying with 37 CFR 1.121 within the 3 months (11 weeks and 2 days) of action 8 including marked up original material to show amendments and clean versions of the amended abstract, specification, claims and drawings both with the original figure numbers and with new figure numbers.
11.	5/23/02			Notice of abandonment stating that paper filed 5/03/02 was not filed on time.
12.		5/29/02		Letter to Assistant Commissioner of Patents explaining that the Inventor felt that the reply to the Patent Office's 2/13/02 request was due 5/13/02 because: 1) the Patent Office requested a 3 month response from the Final Action which had already expired on 1/04/02, and 2) the Patent Office requested a \$55.00 late fee on 2/08/02.
13.	6/21/02			Statement that the advisory action mailed 2/13/02 did not set a new three month shortened statutory period for a reply.
14.		6/25/02		Inventor's request for advice on what action was required to complete the patent action and more detail provided on the timing of the Inventor's actions.
15.	7/25/02			Notice that the Applicant is required to file a petition under 37 CFR 1.137 for revival of the application.
16.		8/07/02	8/12/02	Applicant files a petition under 37 CFR 1.137 (a) <u>OR</u> 37 CFR 1.137 (b) for revival of the application.
17.	10/03/02			Letter from petitions attorney dismissing petitions under 37 CFR 1.137 (a) <u>AND</u> 37 CFR 1.137 (b).
18.		11/15/02		Response to reactivate patent per 37 CFR 1.137 (a) showing errors on the part of USPTO in assessing the inventor's timing.